UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,751	01/04/2001	Pnina Fishman	2786-0142 P	4072

2292 7590 01/28/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER	
YOUNG, JOSEPHINE	
ART UNIT	**PAPER NUMBER**
1623	13

DATE MAILED: 01/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/700,751	FISHMAN, PNINA	
	Examiner	Art Unit	
	Josephine Young	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-56* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's election of Species (b) in Paper No. 12, received November 21, 2002, is acknowledged. Because Applicant did not state that the election requirement was traversed and did not distinctly and specifically point out any supposed errors in the election requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Supplemental Election/Restrictions

Further restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9, 19 and 22-25, drawn to methods to induce G-CSF production/secretion and proliferation/differentiation of bone marrow or white blood cells using an adenosine A3 receptor agonist (A3RAg).

Group II, claim(s) 1-9, drawn to methods to induce G-CSF production/secretion using an adenosine A1 receptor agonist (A1RAg).

Group III, claim(s) 1-9, drawn to methods to induce G-CSF production/secretion using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A1 receptor agonist (A1RAg).

Group IV, claim(s) 19 and 22-25, drawn to methods to induce proliferation/differentiation of bone marrow or white blood cells using an adenosine A2 receptor antagonist (A2RAn).

Group V, claim(s) 19 and 22-25, drawn to methods to induce proliferation/differentiation of bone marrow or white blood cells using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A2 receptor antagonist (A2RAn).

Group VI, claim(s) 10-18, 20-21 and 26-40, drawn to methods to treat drug-induced leukopenia and other like toxicities using an adenosine A3 receptor agonist (A3RAg).

Group VII, claim(s) 10-18, 20-21 and 27, drawn to methods to treat drug-induced leukopenia and other like toxicities using an adenosine A1 receptor agonist (A1RAg).

Group VIII, claim(s) 10-18, 20-21 and 27, drawn to methods to treat drug-induced leukopenia and other like toxicities using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A1 receptor agonist (A1RAg).

Group IX, claim(s) 26 and 28-40, drawn to methods to treat drug-induced leukopenia and other like toxicities using an adenosine A2 receptor antagonist (A2RAn).

Group X, claim(s) 26 and 28-40, drawn to methods to treat drug-induced leukopenia and other like toxicities using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A2 receptor antagonist (A2RAn).

Group XI, claim(s) 10-12, 15-18, 20-21, (27) and 41-56, drawn to methods to treat abnormal cell growth such as cancer using an adenosine A3 receptor agonist (A3RAg).

Group XII, claim(s) 41-49, drawn to methods to treat abnormal cell growth using an adenosine A2 receptor agonist (A2RAg).

Group XIII, claim(s) 41-49, drawn to methods to treat abnormal cell growth using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A2 receptor agonist (A2RAg).

Group XIV, claim(s) 10-12, 15-18, 20-21 and 27, drawn to methods for therapeutic treatments other than drug-induced toxicity, such as leukopenia, or abnormal cell growth, such as cancer, using an adenosine A3 receptor agonist (A3RAg).

Group XV, claim(s) 10-12, 15-18, 20-21 and 27, drawn to methods for therapeutic treatments other than drug-induced toxicity, such as leukopenia, using an adenosine A1 receptor agonist (A1RAg).

Group XVI, claim(s) 10-12, 15-18, 20-21 and 27, drawn to methods for therapeutic treatments other than drug-induced toxicity, such as leukopenia, using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A1 receptor agonist (A1RAg).

The inventions listed as Groups I-XVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

The technical feature linking claims 1-56 appears to be that they all relate to methods for using adenosine A3 receptor agonists, for example to induce G-CSF secretion, to treat drug-induced toxicities or to treat abnormal cell growth.

However, KOHNO (1449, mailed April 29, 2002) teaches that adenosine A3 receptor agonists induce apoptosis in HL-60 human promyelocytic leukemia cells. See Abstract. Therefore, by 1996, methods to treat abnormal cell growth using adenosine A3 receptor agonists were known in the art.

Thus, the technical feature linking the inventions of Groups I-XVI does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be methods to induce G-CSF production/secretion and proliferation/differentiation of bone marrow or white blood cells using an adenosine A3 receptor agonist (A3RAg).

The special technical feature of Group II is considered to be methods to induce G-CSF production/secretion using an adenosine A1 receptor agonist (A1RAg).

The special technical feature of Group III is considered to be methods to induce G-CSF production/secretion using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A1 receptor agonist (A1RAg).

The special technical feature of Group IV is considered to be methods to induce proliferation/differentiation of bone marrow or white blood cells using an adenosine A2 receptor antagonist (A2RAn).

The special technical feature of Group V is considered to be methods to induce proliferation/differentiation of bone marrow or white blood cells using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A2 receptor antagonist (A2RAn).

The special technical feature of Group VI is considered to be methods to treat drug-induced leukopenia and other like toxicities using an adenosine A3 receptor agonist (A3RAg).

The special technical feature of Group VII is considered to be methods to treat drug-induced leukopenia and other like toxicities using an adenosine A1 receptor agonist (A1RAg).

The special technical feature of Group VIII is considered to be methods to treat drug-induced leukopenia and other like toxicities using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A1 receptor agonist (A1RAg).

The special technical feature of Group IX is considered to be methods to treat drug-induced leukopenia and other like toxicities using an adenosine A2 receptor antagonist (A2RAn).

The special technical feature of Group X is considered to be methods to treat drug-induced leukopenia and other like toxicities using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A2 receptor antagonist (A2RAn).

The special technical feature of Group XI is considered to be methods to treat abnormal cell growth such as cancer using an adenosine A3 receptor agonist (A3RAg).

The special technical feature of Group XII is considered to be methods to treat abnormal cell growth such as cancer using an adenosine A2 receptor agonist (A2RAg).

The special technical feature of Group XIII is considered to be methods to treat abnormal cell growth using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A2 receptor agonist (A2RAg).

The special technical feature of Group XIV is considered to be methods for therapeutic treatments other than drug-induced toxicity, such as leukopenia, or abnormal cell growth, such as cancer, using an adenosine A3 receptor agonist (A3RAg).

The special technical feature of Group XV is considered to be methods for therapeutic treatments other than drug-induced toxicity, such as leukopenia, using an adenosine A1 receptor agonist (A1RAg).

The special technical feature of Group XVI is considered to be methods for therapeutic treatments other than drug-induced toxicity, such as leukopenia, using an adenosine A3 receptor agonist (A3RAg) in combination with an adenosine A1 receptor agonist (A1RAg).

Accordingly, Groups I-XVI are not so linked by the same or corresponding special technical feature as to form a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josephine Young whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (703) 308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

JY
January 27, 2003

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600